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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/480,344	01/10/2000	KEVIN MICHAEL RUPPELT	9D-EC-19337	4210

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EXAMINER

CHANG, SABRINA A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/480,344

Applicant(s)

RUPPELT ET AL.

Examiner

Sabrina Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's amendments to claims 1, 7, 14, 19 and 25 and the addition of claims 30-45 have been fully considered.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-29, filed November 16, 2003 – Paper 16 – have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

Claims 1 –13, and 30 – 33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 –16 of copending Application No. 09/681,393. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of configuring a product is the same, regardless of the fact that the products or the features stored in association with them are not identical

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 14-18, and 34-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17- 29 of copending Application No. 09/681,393. Although the conflicting claims are not identical, they are not patentably distinct from each other because the system for facilitating selection of a product is the same, regardless of the fact that the products are not identical

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These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Claims 25 – 29 and 42-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30 – 35 of copending Application No. 09/681,393. Although the conflicting claims are not identical, they are not patentably distinct from each other because the system for facilitating selection of a product is the same, regardless of the fact that the products are not identical

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 3, 5, 6, 9 –11, 13 –19, 22, 23, and 25- 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the service MatchMaker<sup>(SM)</sup> offered by www.grainger.com (as excised from the webpages www.grainger.com dated July 1997) in view of the product-finding service offered by Design News (as described in the article “Manufacturing Marketplace opens for business on the WWW” November 18, 1996. Design News).

MatchMaker<sup>(SM)</sup> is a product selection tool that guides users through www.grainger.com’s large Internet-based catalog (inherently comprising circuitry, programming, etc). A user begins using the system by choosing a particular group of products to

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search – motors, casters, motorstarters or lamps (receiving a product category selection). The user then selects from a number of product criteria in the specification table (presenting product configuration criteria, inserting or deleting a product configuration parameter, selection of “critical-to-quality” criteria). The number of products that fit the particular criteria selected by the user is indicated in the text at the top of the page. As the user continues to select specifications from additional categories in the table, the number of available items is reduced (responsively updating the product matrix). When the user feels that the resultant pool of available items is reasonable, he/she can click on the number to view a list of products (matrix) that match the search criteria. Each line item on the list provides a hyperlink to more information about the product.

MatchMaker<sup>(SM)</sup> does not explicitly disclose that the system is designed specifically for the sale of refrigerators, washers, dryers or air conditioners. Grainger discloses only systems that are designed to sell lamps, motors, motorstarters and casters - a user could then only search for products based upon features associated with these particular devices.

However, the difference then between Grainger and the applicant’s invention is only found in the non-functional data stored in the catalog. Data identifying the appliances and the features of the appliances are not functionally related to the catalog/selection tool or how it works. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Examiner would like to point out that all of the features used for product-selection as recited in the claims – such as temperature, color, energy efficiency ratio, etc. – are well-known

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in the art of household appliances to describe air conditioners, refrigerators, washers and dryers [See webpages excised from Maytag.com, Whirlpool.com, Kenmore.com and Frigidaire.com] and would have been an obvious design choice by the catalog administrator in defining the parameters of each appliance.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the fields of the catalog– whether for a lamp, motor, air-conditioning unit or otherwise – for use in the product-finding MatchMaker<sup>(SM)</sup> system, as shown in Grainger, because such data does not functionally relate to the selection tool itself and merely labeling the data differently from that in the prior art would have been obvious matter of design choice. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

A similar analysis applies to claims 7, 8, 12, 20 and 21. Grainger does not explicitly disclose:

- Displaying the matrix comprises displaying column headings including model number, price and product configuration heading for parameters
- Determining a selected column heading based on external input and sorting matrix based on heading.
- Displaying product entries sorted by a selected column heading, for example brand name

The method of display does not have any functional effect on the selector tool itself. It has already been established that the Grainger catalog stores all relevant product data in its catalog/database. Where database columns/rows can be sorted, the manner in which the product matrix of matching items is displayed has no effect on the tool itself. These methods of display are merely a matter of design choice.

MatchMaker<sup>(SM)</sup> does not explicitly disclose that the guidance of the product configuration is presented using a question and answer process.

“Manufacturing Marketplace” teaches a product finding guide. The service assists the user by taking them step-by-step through a series of multiple-choice questions about their desired specifications. After inputting the user’s answers, the finder searches the product database for matching items, which are then displayed.

The question and answer format is just another well-established [See also articles Hoffman, Jones and “Soliloquy”] user-friendly means to obtain a user’s desired specifications for comparison to those of the available products in a catalog/database.

It therefore would have been obvious to one skilled in the art at the time, to modify the system of MatchMaker<sup>(SM)</sup> to present criteria selection to the user in question and answer form, as taught by “Manufacturing”, to provide the user with a more user-friendly means of inputting their desired product specifications.

Claims 4, 24 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the service MatchMaker<sup>(SM)</sup> offered by www.grainger.com (as excised from the webpages www.grainger.com dated July 1997) in view of the product-finding service offered Raychem (as taught in the article “Raychem intros sourcing site” Trommer, Diane. March 16, 1998. Electronic Buyers’ News) in view of official notice regarding e-commerce website design.

MatchMaker<sup>(SM)</sup> does not disclose side-by-side product comparison capabilities.

Raychem discloses an Internet-based product selector tool that matches customer-specified criteria to product descriptions in the Raychem catalog. Users can click a “compare products” link on the resulting list of products (matrix) to see a side-by-side comparison of each of the identified items. For more detail, the users can click on part numbers to access data on each item individually.

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In that both Grainger and Raychem offer product selecting tools, it would have been obvious to modify the system of Grainger to also include the ability for side-by-side comparison of products that meet user specifications, as taught by Raychem, in order to enable the customer to make a more educated purchase and evaluate all of their options in a more efficient manner.

The system of Grainger/Raychem does not explicitly provide for a comparison "toggle" button to selectively choose products for comparison. Examiner takes official notice that selection of products for side-by-side comparison is generally well known [see "pcOrder.com"] and that using "toggle" buttons is well known in the art of e-commerce website design as a means of implementation.

It would have been obvious to modify the system of Grainger/Raychem to provide for compare "toggle" buttons in order to limit the user's comparison chart of products to only the items that most interest him/her.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The articles Lange, Lange and Millstar discuss different product-selector tools. The articles do not however discuss the systems in adequate detail.

The articles regarding Calico, Teresko and Sweat, disclose an Internet-based software package that guides a customer through a vendor's product catalog (database). However the package is geared toward configuration of complex products. Calico does not disclose the matching of customer specifications to existing/available products.



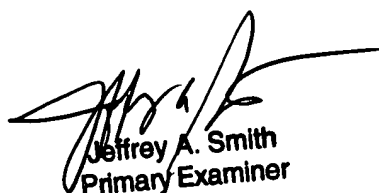
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703 308 3588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC



Jeffrey A. Smith  
Primary Examiner